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Alexander Shvarts FISH & NEAVE 1215 Avenue of the Americas New York,, NY 10020-1105			ART UNIT 2614	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,127

Applicant(s)

SCHEIN ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 26 July 2004 have been fully considered but they are not persuasive.

With respect to applicant's remarks concerning the equivalence of "VCRs" and "digital storage devices" for their use in the recording art, it is noted that in order to adequately traverse an examiner's finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP 2144.03. Accordingly, the applicant's traversal is not timely given that the applicant choose not to traverse the noted fact in their initial response.

Assuming arguendo that the traversal was timely and proper, the Kaminaga et al. (US Pat No. 4,882,732) reference discloses the existence of VCRs that are "digital storage devices" at least as earlier as circa 1989. The Peers et al. (US Pat No. 4,689,022) reference illustrates a method wherein a VCR is a digital storage device and the Endoh et al. reference (US Pat No.

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5,170,388) provides a showing of equivalence between a VCR storing information either in an analog or digital format (Col 1, Lines 14-28) circa at least as early as 1992.

With respect to the rejection of claims 24 and 41 under 35 U.S.C. 112, first paragraph, the applicant submits further remarks and evidence of an adequate written description. However, the cited section appears to be insufficient. It is the examiner's understanding that the cited section discloses the usage of a program information database associated with the IPG that allows a user to designate the program to be retrieved for digital storage wherein the digital storage device is a peripheral storage apparatus of the set-top box (§ [0007]). There is no disclosure or particular reference that the programs necessarily reside upon a "database". In order to overcome the rejection, the examiner suggests amending the claim in a manner consistent with Figure 10 so as to read "the IPG of claim 1, further comprising a [second database] server electrically coupled to the second network and accessible from the IPG for storing television programs; and means for retrieving a stored program; and means for storing the retrieved television program in the storage device".

In response to applicant's argument that the references fail to show certain features of applicant's invention in connection with claims 1, 25, and 42, it is noted that the features upon which applicant relies (i.e., controlling the storage device over network 14) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, the claims merely require arbitrarily designated networks to be "coupled" to one another which is illustrated in Figure 1. Furthermore, the reference teaches that the CPU [58] controls the

operation of the interactive station [18] including the processing and delivery of requests to the headend (Col 7, Lines 44-51). These operations include the activation of a remote or local storage device (Col 14, Lines 9-16).

With respect to the rejection of claims 3, 27, and 43, the examiner disagrees that the particular designation of “networks” is improper. The particular designation of elements as comprising a “first” or “second” network is an arbitrary designation/labeling of components. As illustrated in Figure 1, the system comprises a plurality of “networks” all of which serve to couple all of the elements within the system to each other. For example, the system may comprise an external network interconnected to the headend via the WAN gateway [28], a network within the headend [24], a distribution network [14], and a “home network” serving to interconnect the cable distribution network [14] and the various A/V devices [16]. Those skilled in the art, would recognize that various other designations and/or combinations could be envisioned. As such, any two of the plurality of “networks” could have been utilized in connection with rejection of the independent claims so as to meet the broadly claimed designation of a “first” and a “second network”. The particular elements designated in connection with the rejection were the easiest to designate given their labeling. Later dependent claims were more limiting with respect to the particular designation/nature of the network. Accordingly, the examiner was required to designate differing elements so as to address the limitations. Rather than repeating all of the common components in the statement of rejection (ex. databases, television tuner, etc.), the rejection merely designated the particular sub-set of networks required to meet the claimed limitations and set forth how the rejection of the independent claims would need to be modified. Furthermore, while it is

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not considered necessary, a restatement of the grounds of rejection of claims 3, 27, and 43 in view of the modification of the independent claims would not be construed as a new grounds of rejection, given that merely writing the claim in independent form would require the examiner restate the rejection of claims 1+3, 25+27, and 42+43 with the appropriate substitution of elements. Given such a scenario, it is the examiner's position that it is not improper nor is the reference somehow no longer anticipatory given a different interpretation for differently claimed subject matter of varying scope.

As to the argument that the "second network" is not a "home network", the examiner respectfully disagrees. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The specification as originally filled does not provide any particular definition as to the nature or composition of a "home network". Rather, as cited in the applicant's remarks, the network comprises a series of interconnected home AV devices which can be located in various rooms. The specification does not require for these devices, per se, to be located within different rooms so to constitute a "home network".

As defined in the IEEE 100 Authoritative Dictionary of IEEE Standards Terms 7th Edition, a network is defined as "any set of devices or subsystems connected by links joining (directly or indirectly) a set of terminal nodes" or "an arrangement of components, or ~~nodes~~ ^{nodes}, and interconnecting branches". The Lawler et al. reference in conjunction with Figures 1-2 illustrate that the viewer station [16], which resides in a viewer's home (Col 5, Lines 6-12), comprises a number of interconnected devices including a television [20] terminal, a set-top

box [18], a remote controller [22], and a VCR (not shown) (Col 14, Lines 10-15). Arguably, these devices could reside in the same room or different rooms (using longer interconnections) within the home and still be designated as a form of “home network”.

Accordingly, the applicant’s remarks that interconnected home devices of the Lawler et al. reference do not comprise a “home network” not persuasive particularly in light of the applicant’s disclosed usage of a similar configuration, residing in a single or multiple rooms, and common usage of the term as set forth in the IEEE Dictionary.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the examiner is unclear as to where support for the “second database electrically coupled to the second network and accessible from the IPG for storing television programs” is found.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 6, 8-13, 20-22, 24, 25, 27, 30, 32-34, 40, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawler et al. (US Pat No. 5,585,838).

In consideration of claim 1, the Lawler et al. reference discloses an “interactive program guide” system [10] comprising a “database” [34] that stores “television schedule information” that is “electrically coupled to a first network” [24] (Col 6, Lines 7-21), a “television tuner” [52] that is coupled to a “second network” [14] (Col 6, Line 66 – Col 7, Lines 6, 33-36), a “display monitor” [20] (Col 7, Lines 19-27), a “storage device . . . for storing television programs” (not shown) (Col 14, Lines 10-14), an “input device” [22] (Col 7, Line 66 – Col 8, Line 14), and a “processor” [58] that is operable to “access the database” [34] to retrieve information necessary to “display a portion of the television schedule information on the display monitor in a guide format” (Col 12, Line 60 – Col 13, Line 15) and for “controlling the storage device to store a television program selected from the displayed schedule information” (Col 7, Lines 44-51; Col 14, Lines 22-48).

Claim 25 is rejected as aforementioned in claim 1 wherein the “television schedule information” is “stored” in a “database” [34] that is coupled to a “first network” [34] that may be “accessed” in order to “display a portion of the television schedule information in a guide” [78] on a “display monitor” [20] of a viewer station [16] coupled to a “second

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network” [14]. The viewer station [16] is operable to “receive user inputs” [22/66] and based on these inputs “tune a television tuner” [58] to a “television program selected from the displayed schedule information” (Col 9, Lines 57-67) and “controls a storage device” so as to record or “store a television program selected from the displayed television schedule information” (Col 14, Lines 10-15, 43-48).

Claims 3 and 27 are rejected based on a reinterpretation of the “network” designations such that the “first network” [14] is the network operable to connect the viewer stations [16] with the headend [12] and the “second network” is an inherent “home network” (Col 5, Lines 8-12) between the interconnected devices [18/20/22 + VCR] comprising the viewer station [16].

Claims 6 and 30 are rejected wherein the storage device is a “VCR” (Col 14, Lines 10-14).

Claims 8, 9, 32, and 33 are rejected wherein the “selected television program” may be either a “future television program” or a “current television program” (Col 13, Line 52 – Col 14, Line 48).

Claim 10 is rejected wherein the embodiment comprises means in the form of a remote controller [22] for “controlling the television tuner to tune to the selected television program”. Alternatively, the CPU [58] is operable to control the operation interactive station controller [18] and the “television tuner” [52] (Col 7, Lines 44-51).

Claim 11 is rejected wherein the embodiment would inherently “tune” to the “selected program” once the “future television program” began to be broadcast had it been designated for recording.

Claim 12 is rejected wherein the “tuner” may tune to the “selected program” if it is a “current television program” through the program guide “Go to Show” button [128].

Claims 13 and 34 are rejected wherein the embodiment further comprises a “second database” [34/32] that is “electrically coupled to the second network” [14] and “accessible from the IPG for providing previews of upcoming programs (Col 10, Lines 42-56).

Claims 20, 21, and 40 are rejected wherein the IPG [78] comprises a section [108] for providing “information” including a “picture, video, and descriptive text” about a selected or “particular future program” (Col 10, Lines 28-56).

Claim 22 is rejected wherein the information about a “particular future program” is “interactive in response to the user input” such that the additional information is presented when the user moves the focus frame [102] to that particular program.

In consideration of claims 24 and 41, as aforementioned the Lawler et al. reference discloses the use of a “second database” [32] that is coupled to the “second network” [14] via the “first network” [24] and “accessible from the IPG for storing television programs” associated with PPV services (Col 6, Lines 1-6). The embodiment subsequently provides the “means for retrieving a stored television program” [138] as well as the “means for storing the retrieved television program” [130] in the storage device or VCR.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 2, 4, 5, 7, 23, 26, 28, 29, 31, and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler et al. (US Pat No. 5,585,838).

Claims 2 and 26 are rejected based on a reinterpretation of the "network" designations such that the "first network" [14] is the network operable to connect the viewer stations [16] with the headend [12] and the "second network" inherently comprises the interconnected devices [18/20/22 + VCR] comprising the viewer station [16].

With respect to the "first network" [14] being the Internet, the Lawler et al. reference does not explicitly disclose nor preclude the use of the Internet as a communication medium by which the servers [26] communicate with the viewer stations using a standard bi-directional communication format (Col 6, Lines 32-39). However, the reference suggests that the communication between viewer stations [16] and the head end [12] may be carried by different communication systems that include the use of a modem (Col 7, Lines 1-6). The examiner takes OFFICIAL NOTICE as to the existence of the Internet as a means for conducting bi-directional digital communications. Accordingly, it would have been obvious

to one of ordinary skill in the art at the time of the invention to utilize a bi-directional digital communication path such as the Internet as a component of a “first network” since the Lawler et al. reference explicitly suggests that the embodiment may be implemented using a variety of conventions, standards, or technologies without departing from the underlying concepts of the present invention (Col 5, Lines 41-46) and the Internet, as is known in the art, provides an inexpensive means by which bi-directional data communications may be facilitated.

Claims 4 and 28 are rejected in view of the rejection of claims 2 and 26 wherein the “first network” [14] is the Internet. The “second network” is hence “part of the Internet” in so far as it acts as a “client” of the head end [12] based servers [26].

In consideration of claims 5 and 29, while the “first network” is the Internet and the remote “database” [34] is accessed to retrieve schedule information from this database, the reference does not explicitly disclose nor preclude that the database is necessarily “accessible via a web site”. It would have been an obvious matter of design choice to make the database “accessible via a web site”, since application has not disclosed that the explicit use of a “web site” as a means for the terminal to access the schedule information solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with other means of for remotely accessing a database via the Internet such as via an FTP connection, remote procedure calls, CGI scripts, etc.

In consideration of claims 7 and 31, the Lawler et al. reference discloses the claimed invention except for a “digital storage device”. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a “digital storage device”

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since the examiner takes OFFICIAL NOTICE of the equivalence of “VCRs” and “digital storage devices” for their use in the recording art and the selection of any of these known equivalents to record and store televised programming would be within the level of ordinary skill in the art. Furthermore, it is well known in the art for a “VCR” at the time of the invention to be broadly construed as a “digital storage device”.

Claim 23 is rejected wherein the embodiment further comprises a “second database” [34/34] that is “electrically coupled to the second network” [14] and “accessible from the IPG for providing previews of upcoming programs (Col 10, Lines 42-56). The reference does not explicitly disclose that these “previews” are a form of “advertisement”. It is notoriously well known in the art that “previews” for upcoming pay-per-view programming are a form of “advertisement” for those programs. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made that to utilize the “previews” as “advertisements” for future pay-per-view programming for the purpose of increasing the operator revenue by encouraging viewers to order pay-per-view programs.

In consideration of claim 42, the Lawler et al. reference discloses an “interactive program guide” system [10] comprising a “database” [34] that stores “television schedule information” that is accessible via a network [14] (Col 6, Lines 7-21), a “television tuner” [52] that is coupled to another network (Col 6, Line 66 – Col 7, Lines 6, 33-36), a “storage device . . . for storing television programs” (not shown) (Col 14, Lines 10-14), and a “processor” [58] that is operable to “access the database” [34] to retrieve information necessary to “display a portion of the television schedule information on the display monitor in a guide format” [20] (Col 12, Line 60 – Col 13, Line 15) and for “controlling the storage

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device to store a television program selected from the displayed schedule information” (Col 7, Lines 44-51; Col 14, Lines 22-48).

With respect to the “network” [14] being the Internet, the Lawler et al. reference does not explicitly disclose nor preclude the use of the Internet as a communication medium by which the servers [26] communicate with the viewer stations using a standard bi-directional communication format (Col 6, Lines 32-39). However, the reference suggests that the communication between viewer stations [16] and the head end [12] may be carried by different communication systems that include the use of a modem (Col 7, Lines 1-6). The examiner takes OFFICIAL NOTICE as to the existence of the Internet as a means for conducting bi-directional digital communications. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a bi-directional digital communication path such as the Internet since the Lawler et al. reference explicitly suggests that the embodiment may be implemented using a variety of conventions, standards, or technologies without departing from the underlying concepts of the present invention (Col 5, Lines 41-46) and the Internet, as is known in the art, provides an inexpensive means by which bi-directional data communications may be facilitated.

Claim 43 is rejected wherein the “network” is an inherent “home network” (Col 5, Lines 8-12) comprising the interconnected devices [18/20/22 + VCR] of the viewer station [16].

Claim 44 is rejected wherein the “network” is “part of the Internet” in so far as it acts as a “client” of the head end [12] based servers [26].

In consideration of claim 45, while the Internet is utilized as a means to access and retrieve schedule information from the remote “database” [34], the reference does not

explicitly disclose nor preclude that the database is necessarily “accessible via a web site”. It would have been an obvious matter of design choice to make the database “accessible via a web site”, since application has not disclosed that the explicit use of a “web site” as a means for the terminal to access the schedule information solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with other means of for remotely accessing a database via the Internet such as via an FTP connection, remote procedure calls, CGI scripts, etc.

In consideration of claim 46, the Lawler et al. reference discloses the claimed invention except for a “digital storage device”. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a “digital storage device” since the examiner takes OFFICIAL NOTICE of the equivalence of “VCRs” and “digital storage devices” for their use in the recording art and the selection of any of these known equivalents to record and store televised programming would be within the level of ordinary skill in the art. Furthermore, it is well known in the art for a “VCR” at the time of the invention to be broadly construed as a “digital storage device”.

Claim 47 is rejected wherein the “selected television program” may be a “future television program” (Col 14, Lines 30-48).

9. Claims 14-16, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler et al. (US Pat No. 5,585,838), in view of Knee et al. (US Pat No. 5,589,892).

In consideration of claims 14 and 35, the Lawler et al. reference suggests that the embodiment is operable to support a variety of program sources and interactive services (Col 16, Lines 35-38) and may further comprise a number of program guides (Col 12, Lines 22-

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42). However, the reference does not explicitly illustrate that the embodiment further comprises an “icon” for “establishing a link to a product database for purchasing a product”. The Knee et al. reference discloses an interactive program guide that further comprises “icons” [401] for “establishing a link to a product database for purchasing a product” in conjunction with a current program time guide (Figures 43A-E; Col 36, Line 62 – Col 38, Line 35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Lawler et al. embodiment, if necessary, to further provide “icons” that “establish a link to a product database for purchasing a product” for the purpose of providing a new vehicle for marking program-related products and services capable of reaching a very large audience that would not normally tune to existing home shopping channels (Knee et al.: Col 4, Lines 56-60; Col 38, Lines 32-35)

In consideration of claims 15-16 and 36, as aforementioned, the Lawler et al. reference discloses that it is operable to support a variety of program sources and interactive services (Col 16, Lines 35-38). The reference, however, does not explicitly disclose nor preclude that the incorporation of a “link to a service provider data from information independent of the user’s program choice”. The Knee et al. reference discloses an EPG that further comprises such a “link” which provides information pertaining to “sports, news, scores, financial data, and weather information” (Col 45, Lines 26-54). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Lawler et al. reference to provide a “link” to “service provider databases” as disclosed by Knee et al. for the purpose of enhancing the utility of the EPG into a personalized multimedia information

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system with a convenient and highly flexible user interface (Knee et al.: Col 4, Lines 64-67; Col 38, Lines 55-59).

10. Claims 17, 18, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler et al. (US Pat No. 5,585,838), in view of Lawler (US Pat No. 5,758,259).

In consideration of claims 17-18 and 37-38, the Lawler et al. reference suggests that the program guide may be customized based upon user preferences and viewing habits (Col 14, Lines 61-65), however, it does not explicitly disclose nor preclude that this customization may be performed by “searching the first network”. The Lawler reference discloses an interactive program guide wherein a “virtual agent” is operable to “automatically search the first network based on preferences of the user” that are “learned” from “previous user choices” of programming. The virtual agent subsequently uses this information in order to generate a “customized” IPG [80] (Col 4, Lines 43-49; Col 5, Lines 54-59; Col 9, Lines 19-26) for presentation to the viewer. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Lawler et al. embodiment with the “virtual agent” / IPG customization teachings of Lawler for the purpose providing the user with a programming guide that is automatically personalized thus reducing the programming information a viewer must consider to identify appropriate programming selections (Lawler: Col 2, Lines 31-37).

11. Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler et al. (US Pat No. 5,585,838), in view of Harrison (US Pat No. 5,694,163).

In consideration of claims 19 and 39, the Lawler et al. embodiment discloses that the particular menu options and actions associated with the current program could vary and

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could include additional options (Col 14, Lines 16-22), however, it does not disclose nor preclude that these additional options may link to a “chat room Internet site”. The Harrison et al. reference discloses a method wherein a television viewer may participate in an on-line chat room associated with a particular program (Col 3, Line 53 – Col 4, Line 15).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Lawler et al. reference to provide the user with the ability to link to a “chat room Internet site related to a selected program” as disclosed by Harrison for the purpose of providing users with the ability to discuss the current televised program (Harrison: Col 2, Lines 24-51).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The Kaminaga et al. (US Pat No. 4,882,732) reference discloses the existence of VCRs that are “digital storage devices”
- The Peers et al. (US Pat No. 4,689,022) reference illustrates a method wherein a VCR is a digital storage device
- The Endoh et al. reference (US Pat No. 5,170,388) provides a showing of equivalence between a VCR storing information either in an analog or digital format (Col 1, Lines 14-28).

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and

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art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB

October 14, 2004



JOHN MILLER
SUPERVISORY PATENT EXAMINER
ELECTRONIC BUSINESS CENTER 2600